

**REMARKS/ARGUMENTS**

1. In the above referenced Office Action, the Examiner rejected claims 1-3, 5-14, 16-24 and 26-31 under 35 USC § 103 (a) as being unpatentable over Nakano (U.S. Publication No. 2002/0147988) in view of Grzeczowski (U.S. Publication No. 2004/0049785); and claims 4, 15 and 25 under 35 USC § 103 (a) as being unpatentable over Nakano (U.S. Publication No. 2002/0147988) in view of Grzeczowski (U.S. Publication No. 2004/0049785) and further in view of Chatfield (U.S. Publication No. 2002/0138561).

Claims 1-31 are currently pending in this application. The rejections above have been traversed and, as such, the applicant respectfully requests reconsideration of the allowability of claims 1-31.

2. As an initial point, in the Response to Arguments, the Examiner expressed some confusion as to how the claimed invention could be both a “pull” system and a “push” system. While not the subject of a specific rejection, the applicant notes that the claimed invention can operate as both push and pull systems. In particular, the invention can pull email from an email server and then push notification of these messages to a user. This is not inconsistent and is clearly supported by the specification.

3. As discussed above, claim 1 was rejected under 35 USC § 103 (a) as being unpatentable over Nakano (U.S. Publication No. 2002/0147988) in view of Grzeczowski (U.S. Publication No. 2004/0049785). Claim 1 recites in part:

(1) determining whether to inform a user of an interactive television service of receipt of an email message, the determining made independent of any query by the user of any email server or email account;

(2) responsive to determining to inform the user of the receipt of the email message, generating a hot key signal indicating availability of the email message; and

(3) inserting the hot key signal into a content signal transmitted to the user from an interactive television service provider via a network with which the user and the interactive television service provider are connected,

(4) whereby inserting the hot key signal into the content signal comprises multiplexing the hot key signal with the content signal and modulating the multiplexed signal for delivery to the user. [numerals and emphasis added]

In setting forth the basis for the rejection, the Examiner cites Nakano for “determining made independent of any query by the user of any email server or email account” and Grzeczkowski for “multiplexing the hot key signal with the content signal and modulating the multiplexed signal for delivery to the user”. However, Applicant respectfully asserts that this combination of Nakano and Grzeczkowski is inoperable.

Nakano states as follows,

[0014] To achieve these stated and other objects, the present invention is embodied and described as a software application residing on a STB which queries an e-mail server and notifies a user that an e-mail message fulfilling specific filter criteria has arrived. In a preferred embodiment, the e-mail filtering and notification application resides on a Set Top Box (STB) which is connected between a TV content provider, an Internet provider having an e-mail server, and a TV; a software program resident on the STB which allows a user to specify e-mail filter criteria and notification icons which then retain and store those criteria and icons. The software program preferably includes a querying module which queries the e-mail server to determine whether e-mail fulfilling the user-specified criteria has arrived at the e-mail server, and upon arrival of an e-mail fulfilling the criteria, the application notifies the user by posting the notification icons to the STB. [emphasis added]

Therefore, in this combination, the set-top box queries the email server in part (1). In part (2) a hot key signal is generated indicating availability of the email message. However, in part (3), the hot key signal is inserted into a content signal transmitted to the user from an interactive television service provider via a network with which the user and the interactive television service provider are connected.

In this combination, how did the hot key signal get from the set-top box (that performed the email query) to the interactive television service provider? Also, why would the set-top box send information on the availability of email, back to the interactive television service provider, so that the interactive television service provider

could send this back to the set-top box along with the content signal in parts (3) and (4)? Applicant respectfully asserts that Nakano teaches away from this combination. For this reason, Applicant believes that claim 1 and claims 2-5 that depend therefrom, are patentably distinct from the prior art. In particular, while claim 4 is further rejected based on the combination with Chatfield (U.S. Publication No. 2002/0138561), this additional reference does not correct the deficiencies created by the combination of Nakano and Grzeczowski.

4. As discussed above, claims 6, 11, 17, 22 and 27 were also rejected under 35 USC § 103 (a) as being unpatentable over Nakano (U.S. Publication No. 2002/0147988) in view of Grzeczowski (U.S. Publication No. 2004/0049785). As discussed in conjunction with claim 1, the combination of Nakano and Grzeczowski is inoperable. In fact, Nakano teaches away from this combination. For this reason, Applicant believes that claims 6, 11, 17, 22 and 27 and claims 7-10, 12-16, 18-21, 23-26 and 28-31 that depend therefrom, are patentably distinct from the prior art. In particular, while claims 15 and 25 are further rejected based on the combination with Chatfield (U.S. Publication No. 2002/0138561), this additional reference does not correct the deficiencies created by the combination of Nakano and Grzeczowski.

Conclusions

For the foregoing reasons, the applicant believes that claims 1-31 are in condition for allowance and respectfully request that they be passed to allowance.

The Examiner is invited to contact the undersigned by telephone or facsimile if the Examiner believes that such a communication would advance the prosecution of the present invention.

No additional fees are believed to be due. The Commissioner is authorized to charge any fees that are required or credit any overpayment to Deposit Account No. 50-2126 (ATT030076).

RESPECTFULLY SUBMITTED,

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